

### REMARKS

In response to the subject Office Action, Applicant has herein made amendment to the claims and specification in order to overcome the Examiner's objections and to further clarify the distinctions between the cited prior art and the Claimed invention.

In support of patentability, and in preparation for appeal, Applicant hereby incorporates all previous arguments made pursuant to this case by reference. Applicant respectfully asserts that:

1. The Examiner has failed to make out prima facie cases of obviousness because:

- a. as to the method claims (claim 9-13); none of the cited references discloses or hints at a cutting method using a powder-actuated tool (which is designed for use in driving nails and other fasteners into concrete). Uffman doesn't disclose a "powder-actuated tool," which is a gun conventionally used for firing nails into concrete. Uffman is a rotary tool.
- b. Kaiser, Uffman and Bingham are all rotary cutting tools. Rotary cutting explicitly not punch cutting. In fact, it is the deficiencies presented in a rotary cutting method that Applicant's invention seeks to solve. As is clearly presented in Applicant's specification, the particular unidirectional punching approach facilitated by Applicant's claimed invention for forming a hole without the need of the backing plate makes it clear that a punch is not a rotary cutter. As such, the claimed inventions (which all recite the punch limitation) recite elements that are distinct and nonobvious over the prior art. Since these elements are not taught by the references,

the obviousness rejection is improper. The Examiner has failed to provide any credible evidence to traverse Applicant's argument, but rather concludes that "a punch tool performs an equivalent function as a rotating cutting tool."

c. In response to the Examiner's comments in Page 6 of his action. Since Kaiser does not disclose a punch design, Bingham does not disclose the claimed mandrel, Morse does not disclose the claimed punch, mandrel or method, combining these references will not render each and every element of Applicant's claimed invention because all of the claimed elements cannot be found in such combination. Furthermore, there is absolutely no suggestion to combine a punch (Bingham) with two rotary cutters. The determination of obviousness must be made at the time of the claimed invention, and not now in hindsight, as the Examiner appears to be doing. Applicant has provided ample support for why rotary cutters are unsuitable, and therefore teach away from the claimed inventions.

2. Responding to the Examiner's final comment on Page 7, Applicant respectfully asserts that the Morse reference is non-analogous, and the Examiner, while stating the appropriate standard, has failed to apply the standard to our circumstances. If, as here, the reference has not been adequately shown to be in the field of applicant's endeavor, then he must show that it is "reasonably pertinent to the particular problem with which the applicant was concerned." Applicant's claimed punch tool does not perform an equivalent function as a rotating cutting tool; a rotating cutting tool was and is unsuitable for solving Applicant's particular problem, namely

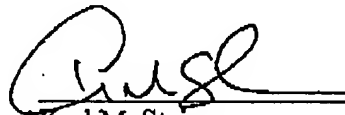
forming holes in steel plates in commercial construction. A rotating tool is the prior art for such problem; a punch is a drastic departure from the prior art.

**Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests that the application be reconsidered, the claims be allowed, and the case passed to issue. If any impediment to the allowance of the claims remains after consideration of this request for reconsideration, and such impediment could be alleviated during a telephone interview, the Examiner is invited to telephone the undersigned so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

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